



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/692,314 08/05/96 HAMLIN

R 910458.CDA

IM62/0815

EXAMINER

JOHN J. GAGEL  
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DYE, R

ART UNIT

PAPER NUMBER

1772

*64*

DATE MAILED:

08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/692,314</b>	Applicant(s) <b>Hamlin</b>
	Examiner <b>Rena L. Dye</b>	Group Art Unit <b>1772</b>

Responsive to communication(s) filed on Apr 21, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 206-217 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 206-217 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 9/15/99 and 4/21/00

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election of Group II, Claims 206-217 in Paper No. 62 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. The rejections of claims 206-217 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,270,086 has been withdrawn in view of Applicant's filing of a terminal disclaimer (approved).

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4. Claims 206-217 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-34 of copending Application No. 08/907,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims recited in related patent application 08/907,170 are generic to, or encompass, the claims recited in the present patent application. Furthermore, in the present patent application, at page 9, lines 10-11, the specification discloses that balloons produced in accordance with the invention may exhibit a burst pressure well in excess of 7 atm. Therefore, the materials used in making the layers of the presently claimed balloon catheter would inherently possess this burst pressure which is the same as that claimed in the related application 09.907,170.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Information Disclosure Statement***

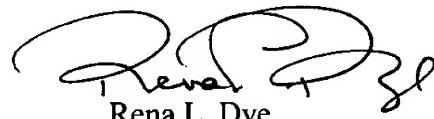
5. The information disclosure statement filed September 15, 1999 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Therefore, the following references have been placed in the application file, but the information referred to therein has not been considered.

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The following non-English references have been struck out on the IDS because a statement of relevance has not been provided: France 998035, France 2328482, German 2848854 A1, Europe 0461474 A1, Europe 0428479 A1, Europe 0292587, Japan 4-34590, and Japan 2-43036.

The second occurrence of Soviet Union 1477423 has been struck out since it is a duplicate citation.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Dye whose telephone number is (703) 308-4331.



Rena L. Dye  
Primary Examiner  
Tech Center 1700

R. Dye  
August 11, 2000